

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Juha PIRKOLA et al
Confirmation No.: 8862
Serial No.: 09/337,330
Filed: June 21, 1999
Group: 2681
Examiner: J. GELIN
For: MOBILITY WITHIN A PACKET-SWITCHED
TELEPHONY NETWORK

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

May 6, 2008

**DECLARATION OF ROBERT BAUER IN SUPPORT OF PETITION FOR REVIVAL
OF UNINTENTIONALLY ABANDONED PATENT APPLICATION**

Sir:

This Declaration is submitted in support of the accompanying Petition for Revival and request for entry of the accompanying Amendment. A Notice of Abandonment dated January 4, 2007 held this application to be abandoned due to the lack of a timely filed response to the Office Action dated May 5, 2006 ("the Office Action"). The entire delay in the filing of the Amendment in response to the Office Action from the non-extendable due date of November 5, 2006 to the filing of the accompanying Petition was unintentional. As indicated below, several circumstances and documents demonstrate the lack of intent.

First, there are three counterpart applications to this application in Canada, Europe and China. We have continued to actively prosecute these counterpart applications, and respond to the Office Actions in these counterpart applications since the May 5, 2006 mailing date of the Office Action in this application. (Copies of the November 27, 2006 Office Action and May 15, 2007 Response in counterpart EP Application 00935423.4-2413 are attached hereto as Exhibit A. Copies of the March 23, 2007 Office Action and August 6, 2007 Response in

counterpart Chinese Application No. 00811870.1 are attached hereto as Exhibit B.) It is inconsistent that we would intentionally abandon this application, while actively maintaining counterpart applications in other countries.

Secondly, it should be noted that the Office Action included an indication of allowable subject matter (see page 7), including claims which applicants had previously amended to be in independent form and paid the necessary fees therefore. An intentional abandonment would have inconsistently removed the benefit obtained by securing the allowance of such claims.

Turning to the Notice of Abandonment, it states that "The Applicant has been noted on 12/26/06 that a notice of abandonment will be mailed shortly." There is no mention of this contact in any of the firm's records. I asked the Examiner, Jean Gelin, about the contact. He indicated that the contact was most likely a phone call, but that he had no record or recollection of the person to whom he spoke. Mr. Gelin indicated that if he had talked to a responsible attorney, his practice was to place the name of the attorney in the statement. I do not recollect personally receiving the phone call. Nevertheless, since the non-extendable due date for filing a Response to the Office Action had already passed, the statement and the contact were of a merely advisory nature.

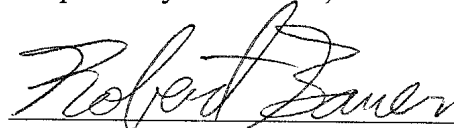
Furthermore, the entire delay in filing the accompanying Petition for Revival in response to the Notice of Abandonment was unintentional. The Notice of Abandonment was mailed on January 4, 2007, docketed in our docketing system and assigned to the responsible Patent Paralegal, Michelle Bombino. Unfortunately, Ms. Bombino was unexpectedly required to appear for jury duty starting on February 5, 2007, and the trial lasted for the entire month of February. During that time, the accumulated workload and backlog grew tremendously. It appears from her time records that she began, but did not finish, the preparation of a Petition to Revive in this application on March 8, 2007. Ms. Bombino soon thereafter tendered her resignation and began to call in sick without completing her employment (see accompanying Declaration of Howard Aronson). I searched the various papers left in the office of Ms. Bombino soon after her departure. Although I was not searching for them specifically, my

search did not turn up a partially completed Petition to Revive or the Notice of Abandonment in this application.

The Notice of Abandonment was docketed, and two alerts were generated by the docketing system on February 4, 2007 and March 4, 2007 (see Exhibit C). Since both of these dates were within the time period that Ms. Bombino was responsible, and there was no alert or reminder after her employment ended, I remained unaware that the Notice of Abandonment had not been completed until Thursday, May 1, 2008. On that date, I was addressing the recent allowance of the counterpart Canadian patent application and sought to compare the allowed claims in that counterpart application to the pending claims in this application. I located and reviewed the file for this application, and noticed that there were no recent papers in the file. Specifically, neither the Notice of Abandonment nor a partially completed Petition for Revive was found in the file. I then looked up this application on Private Pair and discovered the aforementioned Notice of Abandonment. I then promptly conducted an investigation into the relevant circumstances, and prepared the Petition for Revival.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Robert Bauer", is written over a horizontal line.

Robert Bauer, Reg. No. 34,487
Lackebach Siegel, LLP

BECKER • KURIG • STRAUS
MÜNCHEN – BERLIN



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European Patent Office

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Deutschland

May 15, 2007
(KG/DM)

European Patent Application EP 00935423.4-2413

Applicant / Owner: Nokia Corporation
Title: MOBILITY WITHIN A
PACKET-SWITCHED
TELEPHONY NETWORK
Our Ref.: 51008 EP

Responsive to the communication of November 24, 2007

I. Amendments

The pending claims are being maintained without substantial amendments. Minor corrections have been made to the language of claim 1.

II. The prior art

The following document has been cited:

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European Patent Attorneys²
European Trademark Attorneys³**

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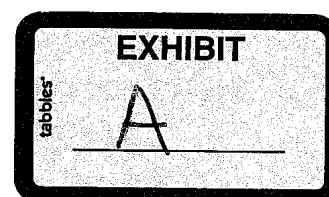
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UST-IdNr.: DE812752671



D1: "Mobile Internet access und QoS guarantees using mobile IP and RSVP with location registers"

D2: WO-A-99 08468

In the article D1 an enhancement to the Mobile IP (MIP) protocol is suggested using location registers, in order to avoid long so-called "triangle routes".

D2 discloses a voice mail service of a closed user group in a mobile communications system.

III. The present invention

Cellular networks and IP-telephony networks are distinct and incompatible networks and do conventionally not allow for any roaming between cellular and IP-telephony networks. Therefore it is an object of the present invention to provide methods and devices which permit roaming or mobility within an IP-telephony network. The object is solved by a method according to claims 1, 6 and 19, and by a system according to claim 29.

IV. Novelty and inventive step

The examiner is of the opinion that D1 already discloses most features of the independent claims. This is respectfully contradicted.

The feature "the visited function sending a message to the subscriber's packet-switched telephony network home function providing a packet-switched telephony **network address of the visited function** in the as updated subscriber location information and the subscriber identification", wherein "the **network address of the visited function** [is stored] as location information for the subscriber" (claim 1) is not disclosed by D1. It is specifically to be noted that the IP address in question here, i.e. that used as location information of the subscriber, is that of the visited function, and not of the mobile terminal connected therewith. In other

words, IP telephony calls are directed to the IP address of the visited function rather than to an IP address of the mobile terminal: “establishing a packet-switched telephony call from the calling entity towards the address of the visited function” (claim 6).

Upon closer review it is apparent that in D1 the relevant IP address is that of the mobile host, not that of the VLR. See p. 1691 par. 4: “Each VLR owns a pool of IP addresses which it can assign visiting mobile hosts as COAs”, “The mobile host obtains a COA from a local DHCP server”. A host wishing to send packets to a mobile host has to query the mobile host’s HLR. From the HLR it will in turn obtain the COA address of the mobile host, and “The correspondent host then directly sends the packet to the mobile host’s COA” (p. 1691 last par.).

That is, rather than establishing an IP telephony call directed to the address of the visited function as in the present invention (which is a single IP address), D1 teaches to establish a packet data connection directed to the IP address/COA (which is one of a plurality of IP addresses) of the mobile host. This can readily be taken from the specification of the present invention: “the subscriber’s Home Function 204 stores a single IP address at which the subscriber can be reached (i.e., the IP address of the serving MIPTN Visited Function). The Home Function 204 is not informed every time the subscriber terminal changes location areas, but rather, only when the subscriber roams to a location area controlled by a different Visited Function (i.e., having a different IP address)” (p. 18, second par.).

Therefore the present invention is novel over D1 at least due to this technical difference.

Leaving apart this fundamental difference, the examiner also believes that the independent claims do not involve an inventive step, as he regards it to be obvious to provide a GSM-like mobility management as of D1 in an IP network or specifically to Voice-over-IP. However, upon closer review it becomes apparent that an arrangement as in the present invention actually contradicts the teaching of D1. As already mentioned the main object of D1 is to avoid so-called “triangle routing”. This is achieved by communicating directly with the mobile host, via the IP address/COA thereof, i.e. without the detour via the VLR. However,

the present invention teaches to establish IP calls via the visited function where a subscriber has roamed, i.e. using a kind of triangle routing.

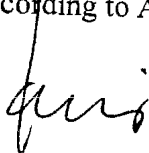
Therefore, leaving apart the fact that D1 does not disclose all claimed features of the invention anyway, it should be apparent that it can not be obvious to an artisan to apply teachings like in D1 to IP telephony networks to arrive at an arrangement according to the present invention in the first place. D1 and the present invention are technically distinct teachings that are not compatible at least due to the colliding objects thereof.

Therefore the present invention also involves an inventive step over D1.

V. Requests

As has been discussed above, the pending claims are novel as well as based on an inventive step. It is therefore requested that the grant of a patent on the basis of these claims is envisaged. It is kindly requested to be allowed to postpone any necessary adaptation of the specification, particularly mentioning the relevant prior art, until allowable claims have been agreed on.

Should the examining division still have substantial objections against the present invention, another communication pursuant Art. 96(2) EPC is requested. In case the examining division should finally deny any inventive aspect within the present application, oral proceedings according to Art. 116 EPC are requested as an auxiliary measure.



Dr. Thomas Kurig

European Patent Attorney

Enclosure:

Corrected claim 1 (with highlighted changes and in fair copy)

Applicant: Nokia Corporation
Our File: 51008 EP (KG/DM)
EP 00935423.4-2413

Corrected claim 1

- 5 | 1. A method of allowing a packet-switched telephony subscriber to roam within a packet-switched telephony network comprising:

 sending a message from a subscriber terminal to a visited function in a packet-switched telephony network, the message including a subscriber identification for the subscriber;

10 | the visited function sending a message to the subscriber's packet-switched telephony network home function, the message providing a packet-switched telephony network address of the visited function ~~in the~~ as updated subscriber location information and the subscriber identification; and

 the home function storing the network address of the visited function as location information for the subscriber.

Applicant: Nokia Corporation
Our File: 51008 EP (KG/DM)
EP 00935423.4-2413

Corrected claim 1

1. A method of allowing a packet-switched telephony subscriber to roam within a
5 packet-switched telephony network comprising:

sending a message from a subscriber terminal to a visited function in a packet-switched telephony network, the message including a subscriber identification for the subscriber;

10 the visited function sending a message to the subscriber's packet-switched telephony network home function, the message providing a packet-switched telephony network address of the visited function as updated subscriber location information and the subscriber identification; and

the home function storing the network address of the visited function as location information for the subscriber.



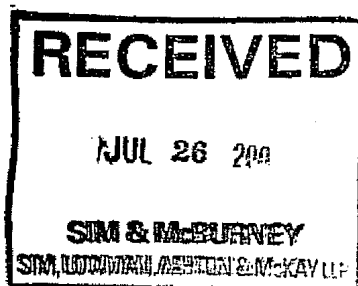
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Date : 2007/07/20

Classification :
H04L 12/66

AVIS D'ACCEPTATION/NOTICE OF ALLOWANCE

N° de demande/Application No. : 2,375,995

12866-4

Date de dépôt/Filing date : 2000/06/12

Votre référence/
Your Reference

: 10841-3 SFF

DAR

Titre de l'invention/
Title of Invention

: MOBILITY WITHIN A PACKET-SWITCHED TELEPHONY NETWORK

Propriétaire(s)/Owner(s)

: NOKIA NETWORKS OY

Revendications/Claims

: 035

Examiné tel que modifié/
Examined as amended

: 2005/05/16

MDC DOCKET

La demande de brevet susmentionnée a été jugée acceptable.

Il faut acquitter la taxe finale de TROIS CENTS DOLLARS (300\$), ou CENT CINQUANTE DOLLARS (150\$) si le requérant a le droit de revendiquer le statut de petite entité et a soumis une déclaration de petite entité, dans les six mois suivant la date du présent avis. Faute de quoi la demande sera réputée abandonnée conformément à l'alinéa 73(1)f) de la Loi sur les brevets.

Une taxe additionnelle de six dollars (\$6) par page excédant 100 pages du mémoire descriptif et dessins devra aussi être payée.

Le brevet sera délivré au nom du dernier propriétaire inscrit à nos dossiers qui a fourni une documentation acceptable, au plus tard à la date du paiement de la taxe finale, conformément à l'article 41 des Règles sur les brevets.

La réponse au présent avis doit comprendre l'identification complète de la demande et la date de l'avis.

La publication des brevets canadiens délivrés dans la Gazette du Bureau des brevets peut comprendre aussi une note concernant la mise en vente d'un brevet ou de sa licence. Si vous désirez profiter de ce service gratuit, veuillez l'indiquer au moment de payer la taxe finale.

The above application for patent has been found allowable.

The final fee of THREE HUNDRED DOLLARS (\$300), or ONE HUNDRED AND FIFTY DOLLARS (\$150) where the applicant is entitled to claim small entity status and has submitted a small entity declaration, must be paid within six months following the date of this notice. Otherwise, the application will be deemed to be abandoned pursuant to paragraph 73(1)(f) of the Patent Act.

An additional fee of six dollars (\$6.00) per page over 100 pages of specification and drawings must also be paid.

The patent shall issue to the last registered owner who has submitted acceptable documentation on or before the date that the final fee is paid (as pursuant to Section 41 of the Patent Rules).

A reply to this notice must include full identification of the application including the date of the notice.

The publication of issued Canadian patents in the Patent Office Record can also include an indication that the patent is available for licence or sale. If you wish to take advantage of this free service, please indicate this when paying the final fee.

Commissaire aux brevets/Commissioner of Patents

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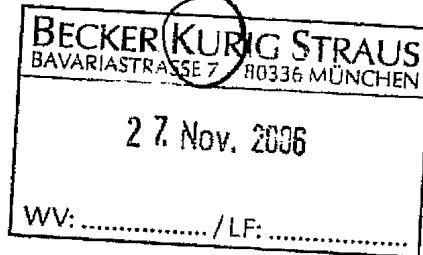
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Application No. 00 935 423.4 - 2415	Ref. 51008 EP	Date 24.11.2006
Applicant Nokia Corporation		

Communication pursuant to Article 96(2) EPC

The examination of the above-identified application has revealed that it does not meet the requirements of the European Patent Convention for the reasons enclosed herewith. If the deficiencies indicated are not rectified the application may be refused pursuant to Article 97(1) EPC.

You are invited to file your observations and insofar as the deficiencies are such as to be rectifiable, to correct the indicated deficiencies within a period

of 4 months

from the notification of this communication, this period being computed in accordance with Rules 78(2) and 83(2) and (4) EPC.

One set of amendments to the description, claims and drawings is to be filed within the said period on separate sheets (Rule 36(1) EPC).

Failure to comply with this invitation in due time will result in the application being deemed to be withdrawn (Article 96(3) EPC).



THU: 240307
- it -

Cretaine, Philippe
Primary Examiner
for the Examining Division

Enclosure(s): 2 page/s reasons (Form 2906)



Beschheid/Protokoll (Anlage)

Communication/Minutes (Annex)

Notification/Procès-verbal (Annexe)

Datum
Date 24.11.2006
Date

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Sheet 1
Feuille

Anmelde-Nr.:
Application No.: 00 935 423.4
Demande n°:

The examination is being carried out on the **following application documents**:

Description, Pages

1-47 as published

Claims, Numbers

1-35 as published

Drawings, Sheets

1/23-23/23 as published

1. An International Preliminary Examination Report has already been drawn up for the present application in accordance with the PCT. The deficiencies mentioned in that report give rise to the following objections under the corresponding provisions of the EPC.
 - 1a. The subject-matter of claims 1-35 does not involve an inventive step in the sense of Article 56 EPC, having regard to the disclosure of D1 = JAIN R ET AL: "Mobile Internet access and QoS guarantees using mobile IP and RSVP with location registers" IEEE INTERNATIONAL CONFERENCE ON COMMUNICATIONS,US,NEW YORK, NY: IEEE, vol. CONF. 5, 7 June 1998 (1998-06-07), pages 1690-1695, XP002114362 ISBN: 0-7803-4789-7
 - 1b. To meet the requirements of Rule 27(1)(b) EPC, the document D1 should be identified in the description and the relevant background art disclosed therein should



be briefly discussed.

- 1c. The features of the claims should be provided with reference signs placed in parentheses to increase the intelligibility of the claims (Rule 29(7) EPC). This applies to both the preamble and characterising portion (see the Guidelines, C-III, 4.11).
- 1d. The vague and imprecise statement in the last paragraph of the description implies that the subject-matter for which protection is sought may be different to that defined by the claims, thereby resulting in lack of clarity of the claims (Article 84 EPC) when used to interpret them (see the Guidelines, C-III, 4.3a). This statement should therefore be amended to remove this inconsistency.
2. The objection mentioned in section VIII.1 of the IPER is not maintained since it is considered that independent claims 1, 6 and 9 meet the conditions of Rule 29(2)(b) and (c) EPC.
3. The PCT application WO 00 35176 published on 15.06.2000 claims the priority date of 09.12.1998. However since the national fee provided for in Article 22, paragraph 1 or Article 39, paragraph 1 of the Co-operation Treaty has **not** been paid, the requirements of Article 158(2) EPC are **not** fulfilled and its content as filed is therefore **not** considered as comprised in the state of the art relevant to the question of novelty, pursuant to Article 54(3) and (4) EPC.
4. The attention of the applicant is drawn to the fact that the application may not be amended in such a way that it contains subject-matter which extends beyond the content of the application as filed (Article 123(2) EPC).

CPEL0154595P

Patent Office of the People's Republic of China

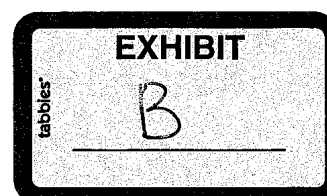
Address : Receiving Section of the Chinese Patent Office, No. 6 Tucheng Road West, Haidian District, Beijing. Postal code: 100088

Applicant	NOKIA CORPORATION <i>Nokia .33CN</i>		Date of Issue
Agent	China Patent Agent (H.K.) Ltd.		March 23, 2007
Patent Application No.	00811870.1	Application Date June 12, 2000	
Title of Invention	MOBILITY WITHIN A PACKET-SWITCHED TELEPHONY NETWORK		

MDC DOCKET

Second Office Action

1. ☒ The examiner has received the Observations, submitted by the applicant on September 20, 2004, and on this basis continued to conduct examination as to substance of the captioned patent application.
☐ On the basis of the Reexamination Decision made by the Reexamination Board of the Chinese Patent Office on _____, the examiner has continued to conduct examination as to substance of the captioned patent application.
☐
2. Further examination has been conducted in the light of the following application document(s):
☐ the amended application document(s) attached to the said observations.
☒ the application document(s) at which the previous Office Action is directed, and the replacement sheet(s) of the amended application document(s) attached to the said Observations.
☐ the application document(s) at which the previous Office Action is directed.
☐ the application document(s) confirmed in the said Reexamination Decision.
☐
3. ☒ In this Office Action no new reference documents have been cited.
☐ The following reference document(s) is/are cited in this Office Action. (Its/Their serial number(s) shall come after those previously cited and will continue to be used throughout the examination procedure):



Serial No.	Number or Title(s) of Reference Document(s)	Date of Publication (or filing date of interfering appl.)

4. Concluding comments of the examiner:

☐ On the description:

- ☐ The amendment to the description is not in conformity with the provision of Art. 33 of the Patent Law.
- ☐ The content of the application comes within the scope where no patent right shall be granted as prescribed in Art. 5 of the Patent Law.
- ☐ The description is not in conformity with the provision of Art. 26, para. 3 of the Patent Law.
- ☐ The drafting of the description is not in conformity with the provision of Rule 18 of the Implementing Regulations.

☒ On the claims:

- ☐ The amendment to Claim(s) _____ is not in conformity with the provision of Art. 33 of the Patent Law.
- ☐ Claim(s) _____ come(s) within the scope where no patent right shall be granted as prescribed in Art. 25 of the Patent Law.
- ☐ Claim(s) _____ is/are not in conformity with the definition of invention in Rule 2, para. 1 of the Implementing Regulations.
- ☐ Claim(s) _____ possess(es) no novelty as prescribed in Art. 22, para. 2 of the Patent Law.
- ☒ Claim(s) 1-10, 12-16, 19-23, 25-34 possess(es) no inventiveness as prescribed in Art. 22, para. 3 of the Patent Law.
- ☐ Claim(s) _____ possess(es) no practical applicability as prescribed in Art. 22, para. 4 of the Patent Law.
- ☒ Claim(s) 11, 24 is/are not in conformity with the provision of Art. 26, para. 4 of the Patent Law.
- ☐ Claim(s) _____ is/are not in conformity with the provision of Art. 31, para. 1 of the Patent Law.
- ☐ Claim(s) _____ is/are not in conformity with the provisions of Rule 20 of the Implementing Regulations.
- ☐ Claim(s) _____ is/are not in conformity with the provision of Art. 9 of the Patent Law.
- ☐ Claim(s) _____ is/are not in conformity with the provision of Rule 23 of the Implementing Regulations.

See the text portion of this Office Action for a detailed analysis of the above concluding comments.

5. In view of the above concluding comments, the examiner deems that

- ☐ the applicant should make amendment to the application document(s) according to the requirements raised in the text portion of this Office Action.
- ☒ the applicant should expound in his/its observations the reason why the captioned patent application is patentable and make amendment to what is not in conformity with the provisions as pointed out in the text portion of this Office Action, otherwise the said application will be rejected.
- ☐ the patent application has no substantive content(s) for which the patent right may be obtained, if the applicant has no sufficient reason to demonstrate that the captioned application may be granted a patent right, said the application will be rejected.

6. The applicant should pay attention to the following matters:

- (1) According to the provision of Art. 37 of the Patent Law, the applicant should submit his/its observations within **two** months from the date of receipt of this Office Action; if, without any justified reason(s), the time limit for making a response is not met, the said application shall be deemed to have been withdrawn.
- (2) The amendment(s) made by the applicant to the application should be in conformity with the provisions of Art. 33 of the Patent Law and Rule 51 of the Implementing Regulations thereof, the amended text should be in duplicate and its form should conform to the relevant provisions of the Guidelines for Examination.
- (3) The observations and/or amended text of the applicant should be submitted to the Receiving Section of the Chinese Patent Office by mail or by personal delivery, if not submitted Receiving Section by mail or by personal delivery, the document(s) will have no legal effect.
- (4) If no appointment is made in advance, the applicant and/or the agent shall not come to the Chinese Patent Office to hold an interview with the examiner.

7. This Office Action consists of the text portion totaling 5 page(s) and of the following attachment(s):

- ☐ copy(copies) of the reference document(s) cited totaling page(s).

Examination Dept. No. _____ Examiner _____

Second Office Action

The applicant submitted the observations and the amended application documents on September 20, 2004. After studying said documents, the examiner conducted further examination on the application, and the following examination opinions are provided:

1. Claim 1 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed a mobile internet access, and the following technical features: the subscribers of packet-switched network roam in the packet-switched network, a mobile host sends a message to a Visitor Location Register (VLR) in the packet-switched network for mobile host registration, the message including a subscriber identification; the VLR sends a message to a Home Location Register (HLR) in the subscriber's home network, providing network address and subscriber identification as access function in the updated subscriber location information; the HLR stores the network address of the VLR as the location information of the subscriber (see pages 16.90-1692 of the description). The difference between said claim and D1 is that claim 1 explicitly mentions "packet-switched telephony network, whereas D1 only solves IP access. However, VoIP technique is a piece of prior art. It is obvious for those skilled in the art to apply the instruction of D1, i.e. the GSM mobile management for

mobile IP access in an IP network, to a packet-switched telephony network, i.e. the VoIP network. Thus, it is obvious for those skilled in the art to derive the technical solution claimed in claim 1 on the basis of D1 combined with prior art. Therefore, said claim does not have prominent substantive features or notable progress, so does not possess inventiveness.

2. Claim 2 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical features: receiving a call for the subscriber; obtaining the location information of the subscriber and the network address of the VLR from the HLR in the packet-switched network; routing the call to the subscriber by establishing a call towards the VLR (see pages 1690-1692 of the description). Although D1 does not disclose “packet-switched telephony call”, it is obvious for those skilled in the art to apply the disclosure of D1 to the packet-switched telephone. Therefore, said claim does not possess inventiveness.

3. Claim 3 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: the VLR forwards the call to the subscriber (see pages 1691-1692 of the description). Thus, said claim does not possess inventiveness.

4. Claim 4 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

The additional technical feature of dependent claim 4 is a piece of common knowledge to those skilled in the art. Therefore, said claim does not possess inventiveness.

5. Claim 5 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: the network address of the VLR comprises IP address (see page 1691 of the description). Thus, said claim does not possess inventiveness.

6. Claim 6 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed a mobile internet access, and the following technical features: the subscribers of packet-switched network roam in the packet-switched network, the HLR receives a call from the mobile host, the call including a subscriber identification; the HLR identifying subscriber location information includes a network address of the VLR corresponding to the subscriber identification; the HLR provides the address of the VLR to the mobile host; the mobile host calls the VLR (see pages 1690-1692 of the description). The difference between said claim and D1 is that claim 6 explicitly mentions “packet-switched telephony network, whereas D1 only solves IP access. However, VoIP technique is a

piece of prior art. It is obvious for those skilled in the art to apply the instruction of D1, i.e. the GSM mobile management for mobile IP access in an IP network, to a packet-switched telephony network, i.e. VoIP network. Thus, it is obvious for those skilled in the art to derive the technical solution claimed in claim 6 on the basis of D1 combined with prior art. Therefore, said claim does not have prominent substantive features or notable progress, so does not possess inventiveness.

7. Claim 7 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D2 (WO9908468) has disclosed a voice mail service, and the following technical features: HLR communicates with the VLR to determine that the subscriber can receive the call prior to providing the VLR to the mobile host (see page 6 of the description and Fig. 2). Since D1 and D2 are of the same art, it is obvious for those skilled in the art to derive the technical solution claimed in said claim on the basis of D1 combined with D2. Therefore, said claim does not possess inventiveness.

8. Claim 8 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D2 has disclosed the following technical features: the HLR communicates with the VLR to determine whether the subscriber can receive the call; providing the VLR address if the subscriber call receive the call; if the subscriber is unable to receive the call, the HLR returns a

subscriber address (see pages 5-7 and 13 of the description). Compared with D2, said claim is different in “the calling entity may leave a voice message for the called subscriber”. Although this is not disclosed in D2, D2 has disclosed voice mail. With the implication of D2, it is easy for those skilled in art to contemplate that the calling entity leaves a voice message to the called subscriber with a voice mail. As D1 and D2 are of the same art, it is obvious for those skilled in the art to derive the technical solution claimed in said claim on the basis of D1 combined with D2 and common technical means. Therefore, said claim does not possess inventiveness.

9. Claim 9 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: the VLR forwards the call to the called subscriber (see pages 1690-1692 of the description). Thus, said claim does not possess inventiveness.

10. Claim 10 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

The additional technical feature of dependent claim 10 is that the step of forwarding the call from the visited function to the called subscriber includes the step of forwarding the call as a packet-switched telephony call to the called subscriber. However, forwarding the call as a packet-switched telephony call is a common technical means for those skilled in

the art to solve said problem. Therefore, said claim does not possess inventiveness.

11. Claim 11 is contrary to the provision of Article 26, para. 4 of the Patent Law.

The additional technical feature of dependent claim 11 “translating ... to a format used by the subscriber terminal that is incompatible with packet-switched telephony” is not stated in the description. Thus, the claim does not use the description as the basis and so it is not supported by the description.

12. Claim 12 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

The additional technical feature of said dependent claim is that the visited function is provided on the called subscriber terminal, which is a piece of common knowledge to those skilled in the art. Therefore, said claim does not possess inventiveness.

13. Claim 13 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical features: sending call control commands between the mobile host and the VLR to set up switching; sending the address of the packet call from the mobile host to the VLR (see pages 1690-1692 of the description). Thus, said claim does not

possess inventiveness.

14. Claim 14 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: sending call control commands between the mobile host and the VLR to set up a packet call (see pages 1690-1692 of the description). Thus, said claim does not possess inventiveness.

15. Claim 15 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: sending call control commands between the mobile host and the VLR through HLR to set up a packet call (see pages 1690-1692 of the description). Thus, said claim does not possess inventiveness.

16. Claim 16 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: the address at the VLR is used for call control commands and media for the call (see pages 1690-1692 of the description). Thus, said claim does not possess inventiveness.

17. Claim 19 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed a mobile internet access, and the following technical features: the subscribers of packet-switched network roam in the packet-switched network, obtaining the location information of the called subscriber from the HLR of the subscriber, the location information including the address of the VLR corresponding to the subscriber identification; establishing a packet call towards the VLR (see pages 1690-1692 of the description). Compared with D1, said claim is different in that it explicitly mentions “gateway function” and “packet-switched telephony call”. However, the gateway function between the PSTN and IP network has been provided in VoIP standard, so is a piece of prior art. Thus, it is obvious for those skilled in the art to derive the technical solution claimed in claim 19 on the basis of D1 combined with H.323 standard. Therefore, said claim does not have prominent substantive features or notable progress, so does not possess inventiveness.

18. Claim 20 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: sending an address request message including the subscriber identification to the called subscriber’s HLR (see pages 1690-1692 of the description). However, it is a piece of common knowledge for those skilled in the art to send address request messages from the gateway to the HLR. Therefore, said claim does not possess inventiveness.

19. Claim 21 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D2 has disclosed a voice mail service, and the following technical features: HLR communicates with the VLR to determine that the subscriber can receive the call prior to receiving the VLR address (see pages 6 and 13 of the description and Fig. 2). Since D1 and D2 are of the same art, it is obvious for those skilled in the art to derive the technical solution claimed in said claim on the basis of D1 combined with D2. Therefore, said claim does not possess inventiveness.

20. Claim 22 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: VLR forwards the call to the called subscriber (see pages 1690-1692 of the description). Therefore, said claim does not possess inventiveness.

21. The additional technical features of claim 23 are the same as those of the dependent claim 10, please refer to the 10th item of this office action for detailed comments. When the cited claim 22 has no inventiveness, the claim has no inventiveness, which is contrary to the provision of Art. 22, para. 3 of the Patent Law.

22. Claim 24 has the same defect as claim 11, so is contrary to the provision of Article 26, para. 4 of the Patent Law (please refer to the 11th

item of this office action for detailed comments).

23. The additional technical features of claim 25 are the same as those of the dependent claim 12, please refer to the 12th item of this office action for detailed comments on the additional technical features. When the cited claim 19 does not possess inventiveness, the claim does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

24. Claim 26 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical features: sending call control commands between the mobile host and the VLR to set up switching; sending the media of the packet call from the mobile host to the VLR (see pages 1690-1692 of the description). In addition, it is a piece of common knowledge to those skilled in the art to send call control commands from the gateway to the VLR. Therefore, said claim does not possess inventiveness.

25. Claim 27 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: sending call control commands between the mobile host and the VLR to set up packet call (see pages 1690-1692 of the description). In addition, it is a piece of

common knowledge to those skilled in the art to send call control signals from the gateway to the VLR. Therefore, said claim does not possess inventiveness.

26. Claim 28 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D1 has disclosed the following technical feature: sending call control commands between the mobile host and the VLR through the HLR to set up a packet call (see pages 1690-1692 of the description). In addition, it is a piece of common knowledge to those skilled in the art to send call control signals from the gateway to the VLR through the HLR. Therefore, said claim does not possess inventiveness.

27. Claim 29 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D2 has disclosed a voice mail service, and the following technical features: GMS mobile communication system includes a home function comprised of a VLR and a mobile switching center, the home function storing current location information and a subscriber profile; said system includes visited functions comprised of a gateway switching center and HLR, each visited function serving an area of the network, the visited function providing the visited function address to the home function, the home function storing the address as subscriber location information (see pages 5-7 of the description and Fig. 2). The difference between said

claim and D2 is that said claim explicitly mentions “packet-switched telephony network”, whereas, D2 concerns GSM network. As VoIP technique is a piece of prior art, it is obvious for those skilled in the art to apply the disclosure of D2 to a packet-switched telephony network with the implication of D2. Thus, it is obvious for those skilled in the art to derive the technical solution claimed in claim 29 on the basis of D2 combined with prior art. Therefore, said claim does not have prominent substantive features or notable progress, so does not possess inventiveness.

28. Claim 30 does not possess inventiveness, so is contrary to the provision of Article 22, para. 3 of the Patent Law.

D2 has disclosed the following technical feature: a subscriber terminal is coupled to a visited function, the subscriber terminal providing a subscriber registration request or location message including a subscriber identification to the visited function (see pages 5-6 of the description). Therefore, said claim does not possess inventiveness.

29. Claims 31-34 do not possess inventiveness, so are contrary to the provision of Article 22, para. 3 of the Patent Law.

The additional technical features of dependent claims 31-34 are: said subscriber terminal is coupled to the visited function via a wireline link, or a wireless link, or a cellular link, or a packet switched network. However, coupling the subscriber to the visited function in said manners

is a common technical means to those skilled in the art. In addition, said coupling manners are commonly known. Therefore, the additional technical features of dependent claims 31-34 do not produce any prominent technical effect. Therefore, claims 31-34 do not possess inventiveness.

The applicant should respond to the problems raised in this office action one by one within the time limit fixed in this office action, and amend the patent application document where necessary, otherwise, the present application is unlikely to be approved. The amendments made by the applicant to the application should conform to the provision of Article 33 of the Chinese Patent Law and not go beyond the scope of the disclosure contained in the initial description and the claims.

Observations

With respect to the Second Office Action issued by the Chinese Patent Office on March 23, 2007, the applicant presents the following observations:

Concerning claims 11 and 24

The Examiner said that the additional technical feature of “translating ... to a format used by the subscriber terminal that is incompatible with packet-switched telephony” is not stated in the description, so it is not supported by the description. But the applicant believes that the contents in lines 20-31 on page 17 of the description can support this additional technical feature.

Concerning claims 1-10, 12-16, 19-23 and 25-34

The Examiner said that said claims lack inventiveness over the reference documents. The reference documents cited in this Office Action are the same as those cited in the first Office Action and the reasons for objection are also the same.

However, the applicant cannot agree to the Examiner’s judgement that said claims lack inventiveness. Concerning the inventiveness, the applicant has the following understanding based on the Chinese Patent Law, the Implementing Regulations thereof and the relevant regulations in the Guidelines for Examination:

The judgment of whether a claim has inventiveness depends on whether the technical solution concerned is obvious to a person ordinarily skilled in the art who has mastered the known knowledge in the art and has access to the documents of the prior art.

As for the judgement of the obvious, it mainly depends on whether there is a corresponding technical inspiration in the prior art. According to the relevant statements in the Guidelines for Examination, the technical inspiration generally includes that the distinguishing features belong to the generally known knowledge in the art, and that the function of the distinguishing feature in the present invention is the same as its function in other technical solutions in the art or in other relevant fields.

The technical inspiration may be either explicit or implicit. But no matter in which form, such technical inspiration should be capable of urging or guiding a common technical person (who is reasonably sensitive to the inspiration and can understand it) to combine the existing techniques to the technical solution that is concerned and to make suitable adjustment so as to obtain the technical solution.

The appropriate technical inspiration should be capable of guiding or urging the common technical persons to perform such a combination (**naturally or with a great probability**), instead of only enabling some technical persons to perform such combination. Therefore, the technical inspiration should be sufficiently **clear and specific**, but it should not merely concern or mention the feasibility of the combination in a vague manner. With respect to the technical contents for which only a possibility of making combination is mentioned, but logical analyses, reasoning or experiment of a uncertain or unknown number of times are still needed for obtaining them, they should not be considered as being readily obtained from the technical inspiration, accordingly, such contents possess inventiveness.

A clear and specific technical inspiration requires the Examiner who stands for denying the inventiveness to provide the content of the inspiration, and to expound **at least** the logical clew for the technical combination. The technical inspiration cannot be considered from a latter-

wit, that is, obtaining said inspiration with reference to the solution of the present invention, because the inspiration understood at this time may be different from that understood on the filing date, so it should be judged whether the inspiration is clear from the technical view when the application is filed.

The technical inspiration should not only explains the possibility of technical combination in terms of an idea, but it should prove that the result of technical combination is predictable.

Concerning the inventiveness of the invention of this application

IP network and packet-switched telephone network are not the same technique, and they have different structures and technical models, the techniques used therein are closely associated with their respective network structures, and their respective techniques are gradually developed based on different network structures, and the technical compatibility is usually a very complex and difficult problem. Applying the technique originally used for one network to another network can not be achieved by a simple combination. There might be some one who had ever conceived combining the techniques thereof, but in fact, no one can state or prove the result or effect of such technical combination and how it is realized.

D1 neither teaches nor suggests that those skilled in the art will (not might) seek technical assistance from other desired fields after reading D1. That is to say, the prior art does not explicitly or obviously suggest that the GSM mobile management technique for mobile IP access can be applied to the packet-switched telephone network. Thus the technical solution of the present invention cannot be readily obtained from D1 (and D2), because the prior art does not give such technical inspiration, at least in the applicant's view. If the Examiner believes that there is such clear inspiration that is either explicit or implicit, please point out it

specifically.

Based on the above analyses, the claims are inventive over D1 and D2. The applicant has expounded the differences between the present invention and the reference documents in the response to the first Office Action. The Examiner accepted such differences but believed that applying the GSM mobile management to the IP telephone network (packet-switched telephone network) would be obvious. However, the applicant disagrees in this regard and would like to reiterate the differences herein:

D1 relates to the problems associated with connecting calls to a roaming mobile terminal in an IP network (see the right column on page 1690), and proposes a solution (see line 21 et seq. in the left column on page 1691). However, D1 and the claims of the present application are different, because D1 is not directed to an IP telephone network (packet-switched telephone network). D2 also relates to a GSM/GPRS cellular network, so it is not relevant to the claimed invention that deals with IP telephone networks. In the present application, the differences between the cellular network and IP telephone network are described.

The applicant does not agree that simply applying the method used in the GSM/GPRS network to the IP telephone network is obvious, and the applicant is of the opinion that the modes claimed in the present application for invention is not obvious.

In addition, in the foreign counterpart application of this application, the applicant's arguments have been accepted by the foreign Examiner.

In summary, the Examiner is respectfully requested to consider the above arguments and made further examination.



Patent: NOKIA.33US, United States, Regular, National, Original Filing

Patent Data

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Country	United States	Agent	
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Filing Type	National	Previous Owner	
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Custom Party #4		Custom Date #1	
Custom Party #5		Custom Text #2	
Custom Party #6		Custom Date #2	
Custom Party #7		Custom Text #3	
Custom Party #8		Custom Date #3	
Agent Ref No		Custom Text #4	
Custom Code #2		Custom Date #4	
Custom Code #3		Text #5	
Custom Code #4		Text #6	
Custom Code #5		Text #7	
Custom Code #6		Text #8	
Custom Code #7		Text #9	
Customer Code	LBPP	Customer Name	Lackenbach Siegel

Title

Mobility Within a Packet...

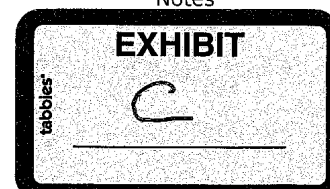
Description

Current Expense Information

Other Case-Related Information

Actions

Action	Action Due Date	Taken Date	Deadline Date	Completed Date	Responsible Atty #1	Responsible Atty #2	Action Notes
No Foreign Filing							
Final Rejection				5/5/2006			
Notice of abandonment				1/4/2007			



Info Discl. Statement	9/21/1999	
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Appeal or RCE Due Reminder - 2 Months	7/5/2006	
Final rejection due	8/5/2006	
Appeal or RCE due	8/5/2006	
Final rejection - 1st extensio	9/5/2006	
Appeal due - 1st extension	9/5/2006	
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Final rejection - 3rd extension	11/5/2006	
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